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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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William F. Rossiter

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EXAMINER

ANDLER, MICHAEL S

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,777	<b>Applicant(s)</b> ROSSITER, WILLIAM F.	
	<b>Examiner</b> Michael Andler	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10,12-15,18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1,3-8,10,12-15,18 and 20-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The examiner acknowledges and has entered the amendment/arguments filed on 24 April 2009. Claims **2, 9, 11, 16-17, and 19** are cancelled by this amendment.

#### ***Claim Objections***

2. Claim **1** is objected to for the following informality:

Regarding claim **1**, the examiner respectfully suggests that the applicant delete "a token precut in card body" and substitute it with --a token precut in the card body--.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- a) Claims **1, 7-8, 10, and 12-13** are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al. (US 5,581,065).

Regarding claims **1, 7-8, 10 and 12**, Nishikawa et al. discloses a card body, comprised of:

an ID-000 format microcircuit card (See Fig 47B, item 41 and Col 1, line 21) precut in the ID-1 format card body (See Fig 47B, item 43 and Col 27, lines 4-6 and Col 21, lines 25-27), and

a token precut in the card body so as to be adjacent to the microcircuit card and extending up to a corner of the card body (See Fig 47B, item 40 where the IC card can be considered adjacent to the IC carrier since they both share

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common sides), the token carrying visual information and including a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring wherein the hole is in a corner of the token in the vicinity of the microcircuit card (See Fig 47B where it is well known in the art to add a keyhole to a corner of a card);

wherein the token includes a magnetic strip configured to store information (Fig 38, item 75).

Regarding claim **13**, Nishikawa et al. discloses wherein the token is connected to the remainder of the card body by mechanically weakened areas consisting of grooves (See Fig 47B, item 44 where the IC card is connected to the IC carrier (the remainder of the card body) where the IC card and carrier together make up the card body as previously shown in claim **1**).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a) Claims **3-6, 14-15, 18 and 20-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (US 5,581,065) in view of Smith et al. (US 7,065,195) and further in view of Pentz et al. (US 6,471,127).

Regarding claims **3-6, 14-15 and 18**, Nishikawa et al. discloses:

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an ID-000 format microcircuit card (See Fig 47B, item 41 and Col 1, line 21) precut in the ID-1 format card body (See Fig 47B, item 43 and Col 27, lines 4-6 and Col 21, lines 25-27), and

a token precut in the card body so as to be adjacent to the microcircuit card and extending up to a corner of the card body (See Fig 47B, item 40 where the IC card can be considered adjacent to the IC carrier since they both share common sides), the token carrying visual information and including a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring (See Fig 47B where it is well known in the art to add a keyhole to a card) and having a furthest distance from the microcircuit card (See Fig 47B, lower right corner which is understood to be furthest from the IC carrier);

wherein the token has sides at least approximately parallel to those of the card body (See Fig 47B where the inner sides of the IC card are parallel to the sides of the card base);

wherein the token has sides at least approximately aligned with the sides of the microcircuit card (See Fig 47B where the inner sides of the IC card are aligned with the sides of the IC carrier);

wherein the token includes a magnetic strip configured to store information (Fig 38, item 75).

Nishikawa suggests a card body that contains both an IC card and a SIM card that are usable in more than one type of telephone (See Figs 47A and 47B) for the

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purpose of making telephone calls. Nishikawa also suggests various configurations for removing SIM cards from sheet frame carriers that leave usable space on the carriers (See Fig 8A).

Nishikawa does not specifically teach that the token is a contactless (RFID) miniature token that has dimensions so as to extend to only one corner of the card body.

Smith et al. teaches a miniature telephone calling card that is attached to a sheet frame carrier that extends to two corners of the card body (Fig 1A and 1B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use a sheet frame card carrier to carry a SIM card and a miniature telephone calling card in order to provide a multipurpose calling card with separable functional parts (Smith et al, Col 1, lines 48-52) and that allows the calling card portion to easily fit in a wallet (Smith et al, Col 3, lines 14-16).

Nishikawa et al. as modified by Smith et al. does not specifically teach that the dimensions of the miniature card would only extend to one corner of the card body and that the miniature card is a contactless (RFID) type token.

Smith et al. suggests that the miniature card body can be of "other dimensions" (Col 3, lines 16-17).

Pentz et al. discloses a miniature telephone calling card whose dimensions would only extend to one corner of the card body (See, for example, Fig 3A) and is a contactless (RFID) type token (Col 5, line 14).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Smith et al. and Nishikawa et al. with the teachings of Pentz et al. in order to provide a means of packaging the miniature calling card of Pentz et al. with a SIM card.

Regarding claims **20-28**, Nishikawa et al. discloses a card comprising:

a body, with a microcircuit card precut in the body (See Fig 47B, items 41 and 43), and

with a token precut in the body so as to be adjacent to the microcircuit card and extending up to a corner of the body (See Fig 47B, item 40 where the IC card can be considered adjacent to the IC carrier since they both share common sides);

the token carrying at least one of visual information and a magnetic strip (See Fig 47B and Fig 38);

wherein the token includes a hole through a thickness of the token configured to receive a key-ring such that the token may be carried by the key-ring (See Fig 47B where it is well known in the art to add a keyhole to a card);

wherein the visual information includes personalizing information and an address or phone number and is in ink and characters in relief (See Fig 47B and Col 25, lines 53-65 where a person of ordinary skill in the art would recognize that a telephone calling card may contain printed or embossed manufacturer logos, access numbers, etc, and can be customized for an individual customer).

Nishikawa suggests a card body that contains both an IC card and a SIM card that are usable in more than one type of telephone (See Figs 47A and 47B) for the

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purpose of making telephone calls. Nishikawa also suggests various configurations for removing SIM cards from sheet frame carriers that leave usable space on the carriers (See Fig 8A).

Nishikawa does not specifically teach that the token is a miniature token that has dimensions so as to extend to only one corner of the card body.

Smith et al. teaches a miniature telephone calling card that is attached to a sheet frame carrier that extends to two corners of the card body (Fig 1A and 1B).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use a sheet frame card carrier to carry a SIM card and a miniature telephone calling card in order to provide a multipurpose calling card with separable functional parts (Smith et al, Col 1, lines 48-52) and that allows the calling card portion to easily fit in a wallet (Smith et al, Col 3, lines 14-16).

Nishikawa et al. as modified by Smith et al. does not specifically teach that the dimensions of the miniature card would only extend to one corner of the card body and leave an L-shaped residual portion detachably connected to the microcircuit card and to the token.

Smith et al. suggests that the miniature card body can be of "other dimensions" (Col 3, lines 16-17).

Pentz et al. discloses a miniature telephone calling card whose dimensions would only extend to one corner of the card body and that would leave an L-shaped residual portion detachably connected to the microcircuit card and to the token (See, for



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example, Fig 3A where it is understood that the miniature card would leave an L-shaped residual portion when removed from the carrier).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Smith et al. and Nishikawa et al. with the teachings of Pentz et al. in order to provide a means of packaging the miniature calling card of Pentz et al. with a SIM card.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims **1, 21-23**, and their respective dependent claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Andler whose telephone number is (571) 270-5385. The examiner can normally be reached on Monday-Friday 7:30 AM to 3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Andler/  
Examiner, Art Unit 2876

/Michael G Lee/  
Supervisory Patent Examiner, Art Unit 2876